

Beiersdorf 753-HCL
100718-357
6713-hf 200/271

REMARKS

Summary of Amendments Made

Claim 19 has been amended to read upon folic acid and has removed the negative limitation "in the absence of vitamin B12" and require the presence of a complexing agent.

Claims 20-22 have been amended to reflect the amendment of claim 19 to read upon folic acid.

Claims 23 and 24 are similar to old claims 31 and 24 respectively.

Claims 25-30 have been amended to describe further limitations of the complexing agent.

Claims 31 has been amended and claim 32 has been added to reflect further limitations of claim 19.

Claims 19-32 are now pending and claims 14-18 are presumed to be withdrawn. It is believed that no new matter has been added.

Since process claims 14-18 are linked to product claims 19-23, if the product claims are held allowable either after consideration of this response or upon reversal of the rejection by the BPAI, it is requested that claim 14-18 be rejoined (see MPEP 821.04). In order to maintain compliance with MPEP 821.04 ("In view of the rejoinder procedure, and in order to expedite prosecution, applicants are encouraged to present such process claims, preferably as dependent claims, in the application at an early stage of prosecution."), claims 14-18 remain pending though withdrawn from consideration.

Comment of 35 U.S.C. 112, first and second paragraph rejections

- (1) The rejection of claims 19-31 for "new matter" has been rendered moot as the negative limitation "in the absence of vitamin B12" has been deleted from the claim. However, the applicants maintain that this rejection was made in error for the reasons previously cited (see also MPEP 2173.05(i) and as such the applicants reserve the right to pursue this subject matter in a divisional application, if necessary.
- (2) The basis for the rejection of claim 26 (use of the commonly known abbreviation, EDTA) has been rendered moot as the applicants have given the full technical name for this compound when used in the claims.

Beiersdorf 753-HCL
100718-357
6713-hf 200/271

35 U.S.C. 102(e)/103(a) rejection

- (1) Claims 19-30 were rejected as being anticipated or in the alternative as being obvious in view of Russ et al. (U.S. Patent 6,299,890).
- (2) Claims 19-31 were rejected as being anticipated or in the alternative as being obvious in view of Kellner et al. (U.S. Patent 6,042,815).

Standard of review for anticipation

MPEP 2131 states that to anticipate a claim, the reference must teach every element of the claim, i.e. "The identical invention must be shown in as complete detail as is contained in the...claim." see *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d, 1913, 1920 (Fed. Cir. 1989). Although the amendments to the claims render the rejection moot, the previous rejection is addressed briefly in order to avoid a similar type of rejection based on new prior art.

Given that the anticipation requires not only that each element be taught but also that the identical invention be shown in as complete a detail as is contained in the claim, the examiner's concession that perhaps the Russ et al. or Kellner et al. references are really more suited for obviousness would appear to be *prima facie* evidence that the invention was not shown in as complete a detail as the applicants claim.

Moreover, for a proper anticipation rejection, the reference "must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." see *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972).

Picking and choosing is also inappropriate for obviousness ("as a whole" requirement)

The examiner cites that Russ et al. and Kellner et al. teach "all the critical elements". However, this can only be true by resorting to picking and choosing which is not only improper for anticipation but also for a determination of obviousness (i.e. consideration of the prior art and the claimed invention "as a whole"). For example, one of ordinary skill in the art having the Russ et al. reference before him without having the applicants' claim before him would surmise that there are three critical components to their invention, i.e. (a) a water phase having solubilized therein an effective amount of soy protein capable of forming a skin firming and toning film on the skin; (b) an oil phase comprising silicone oil having dispersed therein one or more colorants, said silicone oil phase capable of plasticizing the film formed on the skin by the solubilized soy protein in the water phase; and (c) an effective amount of a surfactant capable of

Beiersdorf 753-HCL
100718-357
6713-hf 200/271

causing the water and oil phase to form an emulsion which maintains stability at 50° C for two weeks. As the elements of the applicants' claims are part of a vast array of additional components within Russ et al. or Kellner et al. which when considered "as a whole" represents an infinite number of possible permutations of their respective base invention. As stated in *In re Rice*, 178 USPQ 478, 480 (CCPA 1973) "...the board said, referring to the appellant's ingredients, 'It should be noted that an infinite number of combinations is possible.' Accepting that as an approximation to the truth, we fail to see the obviousness in devising appellant's.....[invention] as claimed." *Id.* at 480.

35 U.S.C. 103(a) rejection

Claims 19-31 were rejected as being anticipated or in the alternative as being obvious in view of Fänger et al. (U.S. Patent 6,153,204).

Similar to the response above to Russ et al. and Kellner et al. made above, when considering the teachings of Fänger et al. as a whole, it is clear that it is directed toward a composition which contains a starch esterified with one or more n-octenylsuccinate radicals and to assert that one of ordinary skill in the art having the reference before him without the benefit of the applicants claims before him would've had the prescience to find a needle in a haystack without any guidance.

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,
Norris, McLaughlin & Marcus, P.A.

By: Howard C. Lee
Howard C. Lee
Reg. No. 48,104

220 East 42nd Street
30th Floor
New York, New York 10017
(212) 808-0700

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR 1.111 (8 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 6 February 2004

By: Agata Glinska
Agata Glinska